

REMARKS

Reconsideration of this application is respectfully requested.

In the Final Official Action, the Examiner reiterates the rejections from the previous Official Action. Specifically, the Examiner rejects claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,602,185 to Uchikubo (hereinafter "Uchikubo") in view of U.S. Patent No. 6,659,939 to Moll et al., (hereinafter "Moll").

In response, the Applicant again respectfully traverses the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

In response to the previous Official Action, the Applicant argued that (1) there is no motivation or suggestion to combine the remote surgery support system of Uchikubo with the tele-surgical system of Moll and (2) the combination of Uchikubo and Moll does not show one or more secondary support rooms for receiving and processing information from the operating room and transmitting a processing result (as secondary support information) to a primary support room (which is not the operating room).

1. NO MOTIVATION OR SUGGESTION TO COMBINE UCHIKUBO AND MOLL

With regard to argument (1), the Examiner has responded in the Final Official Action by arguing motivations which are not related to the objectives of the present invention, namely to prevent the operator in the operating room from receiving all of the information units from supporting rooms. Thus, the Applicant respectfully submits that the motivation cited by the Examiner for combination of the Uchikubo and Moll references is not proper because the inventors of the Uchikubo and Moll references were faced with different problems. "35 U.S.C. § 103(a) requires ... a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with

no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner.” Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (emphasis added) (citing Ruiz v. A.B. Chance Co., 357, F.3d 1270, 1275 (Fed. Cir. 2004)). Since the Uchikubo and Moll references are directed to solving different problems, those of ordinary skill in the art could not have been motivated to combine the teachings thereof. Uchikubo is simply directed to making it possible to check or display the state of a surgical instrument and/or patient information in a remote place (column 1, lines 51-60). Moll is simply directed to methods for coupling input devices to robotic manipulator arms during surgery (see column 1, lines 26-31). Neither of such objectives are even remotely related to the objective of the present invention.

Thus, the rejection of claims 1-21 under 35 U.S.C. § 103(a) is improper and must be withdrawn.

2. COMBINATION OF UCHIKUBO AND MOLL FAIL TO DISCLOSE OR SUGGEST ALL OF THE FEATURES OF THE CLAIMS

With regard to argument (2), in the Final Official Action, the Examiner appears to argue that the system of Moll “is capable of having multiple master control rooms in which several master surgeons are available to offer support to the surgeon in the operating room” and therefore the same is inherent therein (emphasis added). The Applicant respectfully submits that the Examiner’s rejection under such a basis is also improper.

Something is “inherent” in a reference where it is actually disclosed in a reference, albeit not expressly disclosed. The Examiner does not argue that the features discussed above are inherently disclosed but only that the system in Moll is capable of such features. Therefore, the Examiner’s argument that the features are inherently disclosed in Moll is incorrect. Moll does not inherently disclose a system having multiple master control

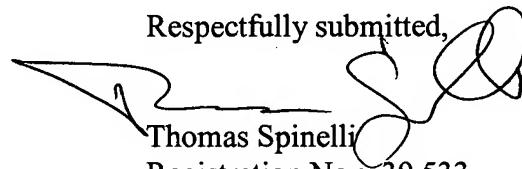
rooms in which several master surgeons are available to offer support to the surgeon in the operating room. Therefore, the combination of Uchikubo and Moll (even if such a combination was proper) does not show one or more secondary support rooms for receiving and processing information from the operating room and transmitting a processing result (as secondary support information) to a primary support room (which is not the operating room).

Thus, assuming arguendo, that the combination of Uchikubo and Moll is proper (which it is not), such a combination does not teach one or more secondary support rooms for receiving and processing information from the operating room and transmitting a processing result (as secondary support information) to a primary support room (which is not the operating room) as recited in the claims. Thus, independent claims 1, 8, and 15 are not rendered obvious by the cited references because neither the Uchikubo patent nor the Moll patent, whether taken alone or in combination, teach or suggest a remote operation support system or method having at least the features discussed above. Accordingly, claims 1, 8, and 15 patentably distinguish over the prior art and are allowable. Claims 2-7, 9-14, and 16-21, being dependent upon claims 1, 8, and 15, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-21 under 35 U.S.C. § 103(a).

Lastly, although such features are not inherent in Moll, the Examiner's statement that the system of Moll is "capable" of such features leads Applicant to believe that the Examiner may be actually arguing that such features are obvious in light of Moll. However, one cannot base obviousness upon what a person skilled in the art could or might try but rather must consider what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 USPQ 6 (CCPA, 1977). However, as discussed above, since

there is no suggestion or motivation in Moll of having multiple master control rooms in which several master surgeons are available to offer support to the surgeon in the operating room, those skilled in the art would not have been led to its teachings to solve the problems addressed by the present invention.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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